



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/692,463

10/21/2003

Brian LaBrec

P901D

7258

23735 7590 07/13/2007

DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

CHEN, VIVIAN

ART UNIT

PAPER NUMBER

1773

MAIL DATE

DELIVERY MODE

07/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/692,463 | Applicant(s) LABREC, BRIAN | |
| | Examiner Vivian Chen | Art Unit 1773 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11,12,15-17,19,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11,12,15,16 and 30 is/are allowed.
- 6) ☒ Claim(s) 1-7,9,17, 19, 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1773

DETAILED ACTION

1. Claim 8, 10, 13-14, 18, 20-29, 32-33 has been cancelled by Applicant.

1. The indicated allowability of previously presented claim 18 is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow.

Specification

2. The amendment filed 4/30/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the newly filed amendments in which the document structure lacks a discernable interface between laminate and core when the core is not limited to polyester.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1773

2. Claims 1-7, 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons stated above in the objection to the amendment filed 4/30/2007. The disclosure as originally filed only provides support for the lack of a discernable interface when the core is specified as polyester and does not provide support for the lack of a discernable interface when the core is unspecified and/or polyolefin.

3. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 is vague and indefinite because it is inconsistent with the parent claim 30 requiring that the core is polyester.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 17, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by:

(a) WINTER (US 4,765,999); or

Art Unit: 1773

(b) YABE (US 4,362,775).

WINTER discloses a method of forming a laminated polyester film via coextrusion wherein the laminate comprises a first polyester layer comprising PCTA and a second bonding layer comprising PETG. (WINTER, line 9-23, 33-58, col. 2; Examples 1-3)

YABE ET AL discloses a method of forming a laminated polyester film via coextrusion wherein the laminate comprises a first polyester layer comprising poly-1,4-cyclohexylenedimethylene terephthalate and a second bonding layer comprising glycol-modified polyethylene terephthalate. (YABE ET AL, line 40-50, col. 2; line 6-38, col. 3; line 1-5, col. 8)

Claim Rejections - 35 USC § 103

4. Claims 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

(a) WINTER (US 4,765,999); or

(b) YABE (US 4,362,775).

WINTER discloses a method of forming a laminated polyester film via coextrusion wherein the laminate comprises a first polyester layer comprising PCTA and a second bonding layer comprising PETG. (WINTER, line 9-23, 33-58, col. 2; Examples 1-3)

YABE ET AL discloses a method of forming a laminated polyester film via coextrusion wherein the laminate comprises a first polyester layer comprising poly-1,4-cyclohexylenedimethylene terephthalate and a second bonding layer comprising glycol-modified polyethylene terephthalate. (YABE ET AL, line 40-50, col. 2; line 6-38, col. 3; line 1-5, col. 8)

Art Unit: 1773

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize a known multilayer film-forming method (e.g., coextrusion) to form a laminate comprising a surface polyester layer and a bonding polyester layer.

Response to Arguments

5. Applicant's arguments filed 4/30/2007 have been fully considered but they are deemed moot in view of the new grounds of rejections.

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 6, 2007


Vivian Chen
Primary Examiner
Art Unit 1773